

### **REMARKS**

Applicants submit this Amendment in response to the final Office Action dated October 20, 2006. Claims 1-29, 44, and 45 are pending. Claims 30-43 are canceled without prejudice or disclaimer. Claims 44 and 45 are added for examination on the merits. No fees are due for added claims 44 and 45. Nevertheless, if the Office deems otherwise, Applicants hereby authorize the Director to charge any fees associated with this application to Deposit Account No. 13-2855 under Order No. 29617/PM478.

In light of the following remarks, Applicants submit that the present application is in condition for allowance and respectfully requests the Examiner to pass the same to issue.

### **CLAIM REJECTIONS – 35 U.S.C. §102**

Claims 1, 2, 6, 7, and 15 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Murasaki et al. (EP 0 427 870 A1). Applicants respectfully traverse this rejection.

It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. *See*, for example, *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity. This standard has not been satisfied with respect to claims 1, 2, 6, 7, and 15 of the present application.

Independent claim 1 recites a transfer tape dispenser comprising, *inter alia*, “a cushion body disposed in [a] case and adapted to bias [an] applicator tip...” While the Office Action alleges that the spring S of Murasaki et al. equates to the “cushion body” recited in independent claim 1, Applicants respectfully disagree.

Specifically, Applicants assert that the spring S disclosed by Murasaki et al. is not a cushion, let alone “a cushion body,” as disclosed in the present application and understood by a person having ordinary skill in the art. The American Heritage Dictionary of the English Language: Fourth Edition (2000) provides one definition of a “cushion” (copy attached as Exhibit A) as follows: “Something resilient used as a rest, support, or shock absorber.” In accordance with such a definition, the specification of the present application describes that

pivoting the applicator tip of the disclosed dispenser compresses the cushion body 94. *See*, for example, page 13, lines 10-14. The specification further states that one example of a “cushion body 94 is a resilient body that when pressed in a direction provides a reaction force in an opposite direction.” Page 14, lines 1-2. Thus, Applicants submit that a cushion body, as claimed in the present application, includes a body that resiliently loads to support, absorb, or dampen a mechanical force.

On the contrary, the spring S disclosed by Murasaki et al. is only capable of loading in tension, whereby it never supports, absorbs, or dampens a mechanical force. With reference to FIGS. 7, 9(a), and 9(b), Murasaki et al. describe the spring S as being attached to a pressure head 5 (or applicator tip). The pressure head 5 is selectively moveable between two positions for applying a transfer film 1a to a receiving surface 4. *See* column 15, line 58 to column 16, line 1. A user determines which of the two positions to use in accordance with a desired application process; in each position, the spring is not capable of acting as a cushion body, as recited in independent claim 1.

For example, a user may switch the pressure head 5 into a first position by pressing a facial press portion 5a of the pressure head 5 against the receiving surface 4, as depicted in FIGS. 7 and 9(a). *See* column 16, lines 20-23. So configured, the spring S is loaded in tension and applies a pulling force to the pressure head 5. However, the pressure applied by the user counteracts the pulling force and fixes the facial press portion 5a against the receiving surface 4. Thus, the spring S does not cushion the pressure head 5 while in the first position because the spring S is constantly under tension and the facial press portion 5a of the head 5 is fixed against the surface 4.

Once the user stops pressing the pressure head 5 into the first position, the spring S pulls the pressure head 5 into the second position, whereby it abuts a stopper 29, as depicted in FIG. 9(b). *See* column 16, lines 26-30. The spring S and stopper 29 fix the head 5 in the second position. *See* column 16, lines 48-52. Therefore, the spring S does not cushion the pressure head 5 in the second position, either.

Thus, as mentioned, Applicants respectfully assert that the spring S disclosed by Murasaki et al. is not a cushion body. On the contrary, the spring S is a switch, which moves the pressure head 5 from the first position to the second position.

For the foregoing reasons, Applicants respectfully submit that the anticipation rejections of claims 1, 2, 6, 7, and 15 over Murasaki et al. should be withdrawn.

### **CLAIM REJECTIONS – 35 U.S.C. §103**

Claims 3-5, 7-14, and 16-29 stand rejected as allegedly obvious over Murasaki et al. in combination with one or more of Vulpitta et al. (U.S. Patent No. 6,681,380), Goodwin et al. (U.S. Patent No. 5,009,739), Huthmacher WO (WIPO Publication No. WO 01/62648), Huthmacher US (U.S. Patent No. 6,796,355), Hsu (U.S. Patent No. 6,453,968), You (U.S. 2004/0033353), and Manusch et al. (U.S. Patent No. 6,079,660).

A *prima facie* case of obviousness requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when combined, must teach or suggest all of the claim limitations. See M.P.E.P. §2143.

Applicants submit that such criteria have not been satisfied, and that each of claims 3-5, 7-14, and 16-29 is allowable over Murasaki et al., whether alone or in combination, for at least the reasons provided above.

Specifically, neither Murasaki et al., nor any other reference of record, teaches or suggests, either alone or in combination, all of the limitations of independent claim 18. For example, similar to independent claim 1 discussed above, independent claim 18 recites a transfer tape dispenser comprising, *inter alia*, “a cushion body disposed in [a] case between [an] applicator tip and an interior surface of the case...” As with the alleged anticipation rejections regarding claim 1, the Office Action relies on Murasaki et al. as the sole source for disclosing a cushion body. However, in light of Applicants’ arguments presented herein establishing the failure of Murasaki et al. to disclose “a cushion body,” the Office Action has also failed to establish a *prima facie* case of obviousness of claim 18.

Furthermore, any proposed modification of Murasaki et al. in view of the cited art would be improper because Murasaki et al. teach away from utilizing a cushion body. Specifically, as described above, Murasaki et al. teach an applicator tip capable of being used in one of two fixed positions. In the first position, a force applied by a user overcomes the tension in the spring S and fixes the facial press portion 5a against the surface 4. In the second position, the spring S fixes the head against the stopper 29. Accordingly, Murasaki et al. do not teach a cushioned applicator tip, but rather, an applicator tip having two fixed, rigid positions. Such a fixed applicator tip is directly contrary to a cushioned applicator tip. Therefore, Murasaki et al. expressly teach away from such a device.

Moreover, the cushion body of the present application advantageously provides for a cushioned applicator tip such that application of transfer tape is smooth and uninterrupted. The cushion body provides for a much easier assembly operation than the tension spring S disclosed by Murasaki et al. because it does not require a traditional spring. Rather, at least in one embodiment, the tape dispenser of the present application comprises a cushion body that is co-molded with the applicator tip, as recited in claims 7 and 20.

For the foregoing reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, the obviousness rejections of claims 3-5, 7-14, and 16-29 over Murasaki et al. have been overcome and should be withdrawn.

#### **NEW CLAIMS**

New claims 44 and 45 have been added herein for examination on the merits. No new matter has been added. Applicants respectfully request prompt and favorable consideration of new claims 44 and 45.

**CONCLUSION**

Applicants believe that all outstanding rejections and/or concerns have been either traversed, accommodated, or rendered moot and, therefore, prompt and favorable consideration of this application is requested. In the event the Office finds any outstanding issue that may be resolved via telephone conference, Applicants hereby invite the Examiner to telephone the undersigned at the number provided below.

Dated: December 20, 2006

Respectfully submitted,

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The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

## cushion

SYLLABICATION: cush-ion

PRONUNCIATION: kōsh'ən

NOUN: 1. A pad or pillow with a soft filling, used for resting, reclining, or kneeling. 2. Something resilient used as a rest, support, or shock absorber. 3. A mat placed or attached beneath carpeting to provide softness and increase durability. 4. A padlike body part. 5. *Games* The rim bordering the playing surface of a billiard table. 6. A pillow used in lacemaking. 7. Something that mitigates or relieves an adverse effect: *extra funds serving as a cushion against future inflation.*

TRANSITIVE VERB: Inflected forms: **cush-ioned, cush-ion-ing, cush-ions**

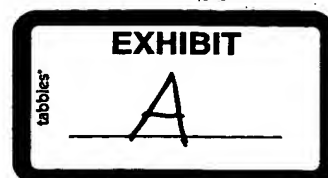
1. To provide with a cushion: *cushion a bench*. 2. To place or seat on a cushion. 3. To cover or hide (something) with or as if with a cushion. 4. To protect from impacts or other disturbing effects: *an automobile suspension that cushions the ride*. 5. To mitigate the effects of; absorb the shock of: *cushion a blow*.

ETYMOLOGY: Middle English *cushin*, from Old French *coussin*, from Vulgar Latin *\*coxīnum*, from Latin *coxa*, hip.

OTHER FORMS: **cush'ion-y** —ADJECTIVE

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